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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,678	08/23/2001	Kazuhito Gassho	110466	8387
7590	04/21/2005		EXAMINER	
Peter B. Martine MARTINE & PENILLA, LLP 710 Lakeway Drive Suite 170 Sunnyvale, CA 25920			DIVINE, LUCAS	
			ART UNIT	PAPER NUMBER
			2624	
DATE MAILED: 04/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,678

Applicant(s)

GASSHO ET AL.

Examiner

Lucas Divine

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/38/02, 8/23/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1½ or double spaced on good quality paper are required.

Claim Objections

2. The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (US 6089765) and Nosaki et al. (US 5673373) hereafter as Mori and Nosaki.

Regarding claim 1, Mori teaches a printing system (CPU 21, Fig. 3 interacts with memories 22, 23, and 24 to execute the cited operations below with separate and distinct software completing the functions) with

a judging portion (software code step S30 [Fig. 4] detects secret information in determining whether to hold a printing job; col. 6 lines 25-29) **which judges whether the received printing job is set to have some secret or not; and**

a selective holder (memory controlling software as run by CPU 21; col. 6 lines 34-35, wherein CPU controls the selection of data to be stored and stores the data in the memory) **which**

refrains from holding the printing job as printing job data in the auxiliary memory device (Fig. 4, NO selection after judging in S30, col. 6 lines 25-32 and 45-57) **even if the set portion is set so that the printing job is still held as printing job data in the auxiliary memory device even after printing is completed** (overrides any other modes because secrecy is implied as the highest priority in col. 6 line 27, wherein no matter what mode the print system is in, it must not save the data), **when the judging portion judges that the printing job is set to have some secret** (col. 6 lines 25-29, wherein a job is deleted if it has been designated as secret), **and**

holds the printing job as printing job data in the auxiliary memory device when the judging portion judges that the printing job is not set to have some secret (Fig. 4, YES step and steps S50 and S60 after judging in step S30).

While Mori teaches a printing system with the decisions of whether or not to store a job for reprinting, Mori does not specifically a comprehensive mode for storing print jobs after printing.

Nosaki teaches a print process occurring in the printer device 2 including a comprehensive mode for storing print jobs after printing (CPU 61, Fig. 3 interacts with memories 61a, and 65 to execute the cited operations below with separate and distinct software completing the functions) including:

a set portion (computer processing steps as shown in Fig. 19 is executed in the print server as a print process) **in which whether or not a received printing job is held as printing job data in an auxiliary memory device** ('secondary memory' holds print jobs when the memory mode is set, secondary memory being the hard disk, which is auxiliary to the main memory 12, Fig. 2) **even after printing of the received printing job is completed** (see Fig. 18, wherein the printing is completed near the bottom, then the process continues to Fig. 19, wherein the memory mode is checked for possible saving of the print job) **is set not for each printing job but comprehensively** (the memory print mode setting as shown in Fig. 19 [col. 11 lines 55-62] is comprehensive in that it is a print operation mode and not an individual job setting or field), **this comprehensive setting being allowed to be performed from a client via a network** (Fig 1 shows the client 1 being able to access the file server and thus the printing device 2 in order to communicated instructions for the device);

and the set portion is set so that the printing job is still held as printing job data in the auxiliary memory device even after printing is completed (if the memory print mode is not set, all jobs are erased from secondary [auxiliary] memory, see last step of Fig. 19).

Each of Mori and Nosaki teach networked printing systems with intelligent printers including the determinations of when a print job should be saved for future use and they both make system decisions based on print jobs designated as secret.

It would have been obvious to one of ordinary skill in the art both the comprehensive and the secret determinations would be beneficial in a single system. Thus, it would have been obvious to add the comprehensive mode of Nosaki to the printing system of Mori. This would create two steps, one that checks whether or not a memory mode is set and one to check if the document was secret, and proceeding as each of the patents teach. The motivation for doing so would have been to allow users to save all jobs (without having to select the option in each and every job) for reprinting but also to make sure that secret data stays that way and isn't stored in the memory for others to see or view. Thus, more precise control for the user with minimal work is attained. Further it would have been obvious to one of ordinary skill in the art that the print process of Mori could have been completed in the printer device as is taught by Nosaki. The motivation for doing so would have been to have the print processes locally running on the printer device so the print process communication did not have to travel across any network and thus save time that the user waits for a job to be printed.

Regarding claim 2, which depends from claim 1, the combination further teaches [in Nosaki]:

a storing portion which temporarily stores the received printing job as printing job data in the auxiliary memory device (as shown in Fig. 4, print device 2 receives the print file [step (3)] and places it in the auxiliary memory 65 [Fig. 3]; col. 5 lines 21-25);

a reader which reads the printing job data from the auxiliary memory device on the occasion of printing (either if the job is not a secret print [Fig. 14] or if it is and the user has to input a password [Fig. 15], the processor begins the print process, which must include reading the file from the secondary memory to perform the print process steps of Figs. 16-19); **and**

an executor which executes printing based on the printing job data read by the reader (Fig. 18 shows the commands near the bottom that perform the execution of a print job on the printer engine [see printer engine 35, Fig. 3]).

Regarding claim 3, which depends from claim 2, the combination further teaches **the selective holder changes the status of the printing job data stored in the auxiliary memory device before printing to a status indicating data in a holding state after printing when the printing job is held as printing job data in the auxiliary memory device after printing is completed** (Mori, Fig. 4, step S30, wherein the judging includes checking what the preset status of the print job is to determine whether or not reprinting was planned or intended [the status was preset]; col. 6 lines 25-26), **and**

deletes the printing job data stored in the auxiliary memory device when the printing job is not held in the auxiliary memory device after printing is completed (in Mori and Nosaki, when the job is not retained, it is deleted, such as in Fig. 19 of Nosaki, wherein the printed print job is erased from secondary memory).

Regarding claim 4, which depends from claim 1, the combination further teaches [in Nosaki] that **the auxiliary memory device is composed of a hard disk contained in the printer** (hard disk 65 [Fig. 3] as part of printer device 2 acts as the secondary memory to store print jobs; col. 3 lines 50-52, col. 5 lines 21-25, and col. 9 lines 23-28).

Regarding claim 5, which depends from claim 1, the combination teaches that **the judging portion judges whether the received printing job is set to have some secret or not by confirming whether this printing job is confidential printing or not** (both Mori and Nosaki teach detecting whether or not the job is 'secret' which implies confidentiality and secrecy of the image data, see Nosaki Fig. 19 middle step and Mori col. 6 line 28).

Regarding claim 6, which depends from claim 1, the combination further teaches the **judging portion judges whether the received printing job is set to have some secret or not by confirming whether setting is performed so that printing is started after a user inputs at least a password when the printing job is printed** (Fig. 15 of Nosaki shows the inputting of the password to print secret data, and then the print process is started).

Regarding claim 7, which depends from claim 1, the combination further teaches **the secret of the printing job is set for each printing job** (Fig. 4 shows that in the printing command there is a separate secret print field that is set or not set for each job [see (1) in Fig. 4]; col. 5 line 47).

Regarding claim 8, which depends from claim 1, the combination further teaches [in Nosaki] that **the secret of the printing job is set for each connection established between the printer and the client** (each connection between client 1 and print server 2 has a field

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designating the secret print or the password to enable the secret print, see Fig. 4, thus it is set for each communication).

Regarding claim 9, the structural elements of apparatus claim 1 perform all of the method steps of method claim 9. Therefore, method claim 9 is rejected for the same reasons as stated above in the rejection of apparatus claim 1.

Regarding claim 10, which depends from claim 9, the structural elements of apparatus claim 2 perform all of the method steps of method claim 10. Therefore, method claim 10 is rejected for the same reasons as stated above in the rejection of apparatus claim 2.

Regarding claim 11, which depends from claim 10, the structural elements of apparatus claim 3 perform all of the method steps of method claim 11. Therefore, method claim 11 is rejected for the same reasons as stated above in the rejection of apparatus claim 3.

Regarding claim 12, which depends from claim 9, the structural elements of apparatus claim 4 perform all of the method steps of method claim 12. Therefore, method claim 12 is rejected for the same reasons as stated above in the rejection of apparatus claim 4.

Regarding claim 13, which depends from claim 9, the structural elements of apparatus claim 5 perform all of the method steps of method claim 13. Therefore, method claim 13 is rejected for the same reasons as stated above in the rejection of apparatus claim 5.

Regarding claim 14, which depends from claim 9, the structural elements of apparatus claim 6 perform all of the method steps of method claim 14. Therefore, method claim 14 is rejected for the same reasons as stated above in the rejection of apparatus claim 6.

Regarding claim 15, which depends from claim 9, the structural elements of apparatus claim 7 perform all of the method steps of method claim 15. Therefore, method claim 15 is rejected for the same reasons as stated above in the rejection of apparatus claim 7.

Regarding claim 16, which depends from claim 9, the structural elements of apparatus claim 8 perform all of the method steps of method claim 16. Therefore, method claim 16 is rejected for the same reasons as stated above in the rejection of apparatus claim 8.

Regarding claim 18, the method steps of method claim 9 are the same as the method steps of program claimed on a medium of claim 18. Further, the references cited both teach performing computer program steps via CPUs and memory in the system. Therefore, claim 18 is rejected for the same reasons as stated above in the rejection of method claim 9.

Regarding claim 19, the structural elements of apparatus claim 19 are the same as those of apparatus claim 1 except for the limitations listed below. Therefore, claim 19 is rejected for the same reasons as rejected claim 1 above. The combination further teaches **a printing system in which a plurality of clients and at least one printer are connected via a network** (Mori, Fig. 1),

wherein the client comprises a transmitter which sets a printing job to have some secret and transmit the printing job to the printer via the network (both Mori and Nosaki teach sending a print job to the printer via the network and the both teach the print jobs possibly having a secret within [see Mori, col. 6 line 28, and Nosaki, Fig. 19]).

Regarding claim 20, the structural elements of apparatus claim 19 perform all of the method steps of method claim 20. Therefore, method claim 20 is rejected for the same reasons as stated above in the rejection of apparatus claim 19.

Conclusion

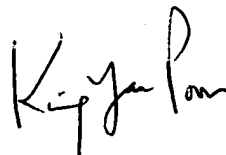
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tang et al., US 6160629, 12-12-2000 : teaches multiple copy printer with print job retention including the ability to set for each job whether it is a private print and whether the job should be stored after printing [see Figs. 4A-4E].

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KING Y. POON
PRIMARY EXAMINER



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Lucas Divine
Examiner
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